

#6
BP
3-3-03

Attorney's Docket No. 043753/241148 (5849-20A)

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Kakefuda *et al.*
Appl No.: 09/997,900
Filed: November 30, 2001
For: GENES AND VECTORS FOR CONFERRING HERBICIDE RESISTANCE IN PLANTS

Confirmation No.: 5699
Group Art Unit: 1638
Examiner: David H. Kruse

February 21, 2003

Commissioner for Patents
Washington, DC 20231

RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Office Action dated January 21, 2003, in which the Examiner has required restriction between Group I, namely Claims 1-14, and Group II, namely Claims 15-21. Applicants hereby provisionally elect with traverse to prosecute the claims of Group I (Claims 1-14) and expressly reserve the right to file divisional applications or take such other appropriate measures deemed necessary to protect the inventions in the remaining claims.

The Office Action asserts that Inventions I and II are unrelated and cites MPEP §§ 806.04 and 808.01 as providing that the "[i]nventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, and different effects." Paper No. 5, p. 2 (emphasis added). The Examiner has not met this standard because the instant specification discloses that the DNA sequence of Group I is capable of use together with the DNA sequence of Group II. As set forth in Claim 15, Group II is drawn to an isolated DNA sequence comprising nucleotides 1-757 of SEQ ID NO:3. The specification discloses that the SEQ ID NO:3 sets forth the genomic DNA sequence of the *Arabidopsis* AHAS small subunit gene and that the promoter of this gene extends from nucleotide 1 to nucleotide 757 of SEQ ID NO:3. See, for example, the Specification, p. 17.

RTA01/2132344v1

In re: Kakefuda *et al.*
Appl No.: 09/997,900
Filed: November 30, 2001
Page 2

Group I is drawn to an isolated DNA sequence encoding a eukaryotic AHAS small subunit protein, including a DNA sequence of the *Arabidopsis* AHAS small subunit gene of SEQ ID NO:3. While the Office Action asserts that the promoter DNA sequence of Group II cannot be used to make the transgenic plant of Group I comprising a DNA sequence encoding a eukaryotic small subunit protein, the instant specification, in contrast, discloses that "[i]n one embodiment, the plant expression vector comprises the *Arabidopsis* AHAS small subunit promoter and a DNA sequence encoding an *Arabidopsis* small subunit AHAS protein." Specification, p. 11. The specification further discloses that "[t]he native promoter of the AHAS small subunit gene in plants may be used for expressing the AHAS small subunit protein gene in transgenic plants." Specification, p. 23. Accordingly, Inventions I and II are not unrelated because they are capable of use together as is disclosed in the instant specification.

In addition, the Examiner is reminded that 37 C.F.R. § 1.142 requires that the inventions be "independent and distinct." According to MPEP § 802.01, "independent" requires that there is no disclosed relationship between the two or more subjects disclosed. The relationship between the DNA sequences of Groups I and II does not meet this standard. As discussed in detail above, Group I and Group II encompass DNA sequences from the same *Arabidopsis* AHAS small subunit gene (SEQ ID NO:3). Therefore, the inventions of Group I and Group II are not independent and distinct.

Further, MPEP § 803 sets forth that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Applicants submit that the search required to examine an isolated DNA sequence comprising a promoter of the *Arabidopsis* AHAS small subunit gene would not be a serious burden because the promoter is from a gene, the *Arabidopsis* AHAS small subunit gene that is encompassed by Group I. Therefore, a search required to examine the DNA sequence of Group II would likely produce results that are a subset

In re: Kakefuda *et al.*
Appl No.: 09/997,900
Filed: November 30, 2001
Page 3

of the results for the search of the DNA sequence of Group I. Accordingly, the examination of the Group I and Group II claims together would not constitute a serious burden on the Examiner, when compared to the examination of the Group I claims alone. For these reasons, Applicants kindly request that the Examiner reconsider and examine the Group I and Group II claims together.

Should the Examiner have further questions or comments with respect to examination of this case, it is respectfully requested that the Examiner telephone the undersigned so that further examination of this application can be expedited.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those, which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,


W. Murray Spruiell
Registration No. 32,943

I hereby certify that this correspondence is being:

CUSTOMER NO. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Raleigh Office (919) 862-2200
Fax Raleigh Office (919) 862-2260

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to Examiner David H. Kruse at the Patent and Trademark Office at facsimile number (703) 872-9306 on the date shown below.

Marilyn Munoz

(Type or print name of person signing certification.)


Signature

2-21-03
Date

This facsimile message and its contents are legally privileged and confidential information intended solely for the use of the addressee. If the reader of this message is not the intended recipient, you are hereby notified that any dissemination, distribution, copying or other use of this message and its contents is strictly prohibited. If you have received this telecopy in error, please notify us immediately by telephone and return the original message to us at the address shown below via the Postal Service. Thank You.

ALSTON & BIRD LLP

3201 Beechleaf Court, Suite 600
Raleigh, NC 27604-1062

919-862-2200
Fax: 919-862-2260

FAX RECEIVED

FEB 23 2003

GROUP 1600**TELECOPY****PLEASE DELIVER AS SOON AS POSSIBLE****OFFICIAL**

DATE: February 21, 2003

TO: USPTO, ATTN: EXAMINER DAVID H. KRUSE

FROM: W. Murray Spruill

NO. OF PAGES:
(including cover page)

4

OPERATOR: 44083

IF NOT RECEIVED PROPERLY, PLEASE NOTIFY ME IMMEDIATELY AT:

USER CODE: SPRUM

FAX NUMBER: (703) 872-9306

CLIENT/MATTER: 043753/241148

REQUESTED BY: Marilyn Munoz

VOICE NUMBER: (703) 306-4539

Alston & Bird

Received from <> at 2/21/03 3:33:18 PM [Eastern Standard Time]